

## REMARKS

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

### **I. Status of the Claims**

This amendment adds, changes and/or deletes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier.

Claim 1 is currently being amended. The amendment to claim 1 is made simply to clarify claim language, as requested by the Examiner. The amendment to claim 1 is not made to overcome any prior art rejections.

Upon entry of this Amendment, claims 1, 3-5, 8, 13-27 and 29-35 remain pending, with claims 3-5, 8, 13-27, and 29-35 withdrawn from consideration because of a restriction requirement, and claim 1 ready to be examined on the merits.

### **II. April 1, 2004, Telephonic Interview with Applicants' Representatives**

Applicants would like to thank Examiner Kifle for his time and insights during a telephonic interview with Applicants' representatives on April 1, 2004. During the telephonic interview, the Examiner agreed that Vorbreuggen et al., *Chemische Berichte*, 117(4):1523-41 (1984), does not anticipate present claim 1. The Examiner also agreed that the finality of the Office Action should therefore be withdrawn.

Applicants respectfully request that the Examiner clarify the scope of the subgenus that the Examiner considers to be free of the prior art.

**III. Response to Issues Raised by Examiner in Outstanding Office Action**

**A. Claim Rejections - 35 U.S.C. § 102**

Claim 1 is rejected by the Examiner under 35 U.S.C. § 102 as being allegedly anticipated by Vorbrueggen et al., *Chemische Berichte*, 117(4):1523-41 (1984). Applicants respectfully request reconsideration and withdrawal of the rejection.

**1. Claim 1 of Applicants' Invention is Distinguishable from Vorbrueggen et al.**

The Examiner asserts that claim 1 reads on the compound of RN 90699-99-3 of Vorbrueggen et al. Specifically, according to the Examiner RN 90699-99-3 corresponds to the present claim 1 when x is 0; -Y-Z-R<sup>2</sup>- is attached to N; Y is ethylene; Z is -N(R<sup>5</sup>)-C(=N-Q)-N(R<sup>7</sup>)-; R<sup>5</sup> is hydrogen and Q is linked to R<sup>2</sup> to form a six-membered ring. Office Action at page 2. Applicants respectfully disagree with the Examiner's analysis and conclusion.

RN 90699-99-3 falls outside the scope of claim 1. Claim 1 contains a proviso that requires at least one of R<sup>5</sup> and R<sup>7</sup> to be aryl(C<sub>1</sub> to C<sub>3</sub>)alkyl or cycloalkyl(C<sub>1</sub> to C<sub>3</sub>)alkyl when Z is -N(R<sup>5</sup>)-C(=N-Q)-N(R<sup>7</sup>)-. In RN 90699-99-3, Z is -N(R<sup>5</sup>)-C(=N-Q)-N(R<sup>7</sup>)-. Therefore, at least one of R<sup>5</sup> and R<sup>7</sup> must be aryl(C<sub>1</sub> to C<sub>3</sub>)alkyl or cycloalkyl(C<sub>1</sub> to C<sub>3</sub>)alkyl. However, neither of the positions in RN 90699-99-3 corresponding to R<sup>5</sup> and R<sup>7</sup> of claim 1 are aryl(C<sub>1</sub> to C<sub>3</sub>)alkyl or cycloalkyl(C<sub>1</sub> to C<sub>3</sub>)alkyl. Therefore, claim 1 is not anticipated by Vorbrueggen et al.

**B. Rejection of Applicants' Claim Language as Being Allegedly Unclear**

The Examiner further asserts that the ring formed when "Q is linked to R<sup>5</sup> or R<sup>7</sup> to form a five-membered ring or Q is linked to R<sup>2</sup> to form a six-membered ring" is unclear because it is not known which atoms are present and what kind of ring (saturated, unsaturated, etc.) is intended. Office Action at page 2. Applicants respectfully disagree with the Examiner's analysis and conclusion. However, to expedite prosecution, Applicants have deleted this language from claim 1. Applicants reserve the right to pursue the deleted subject matter in subsequent divisional applications.

**C. The Finality of the Office Action Should be Withdrawn**

In the outstanding Office Action, the Examiner levied a new ground of rejection under 35 U.S.C. §102(b). MPEP § 706.07(a) states that a “second or any subsequent action on the merits shall be final, *except* where the Examiner introduces a new ground of rejection that is neither necessitated by Applicant’s amendments of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 C.F.R. § 1.97(c) with the fee set forth in 37 C.F.R. § 1.17(p).” Applicants did not amend the claims in their November 26, 2003, Amendment, nor did they file an information disclosure statement during the period set forth in 37 C.F.R. § 1.97(c) with the fee set forth in 37 C.F.R. § 1.17(p).

Additionally, as discussed above in the summary of the telephonic interview with the Examiner, upon reconsideration the Examiner agreed that Vorbrueggen et al. does not anticipate the claimed invention. Therefore, the finality of the Office Action should be withdrawn.

**IV. CONCLUSION**

The present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant(s) hereby petition(s) for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date April 26, 2004

By Michele M. Simkin

FOLEY & LARDNER LLP  
Customer Number: 22428

22428

PATENT TRADEMARK OFFICE

Telephone: (202) 672-5538

Facsimile: (202) 672-5399

Michele M. Simkin  
Attorney for Applicant  
Registration 34,717